

REMARKS

Applicant appreciates the Examiner's thorough consideration provided in the present application. Claims 1-4, 8, 11-13, 16-18 and 23 are currently pending in the instant application. Claims 1 and 23 are independent. Claims 1 and 23 have been amended by way of this response. Reconsideration of the present application is earnestly solicited.

Reasons for Entry of Amendment

As discussed in greater detail hereinafter, Applicant respectfully submits that the rejections under 35 U.S.C. § 103(a) are improper and should be withdrawn. Accordingly, the finality of the Final Office Action mailed on April 4, 2003 should be withdrawn.

In accordance with the requirements of 37 CFR 1.116, Applicant respectfully requests entry and consideration of the foregoing amendments as they remove issues for appeal and place the current application in a condition for allowance.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 3, 8, 11, 13, 16 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo et al. (U.S. Patent No. 5,828,461) in view of Nielsen et al. (U.S. Patent No. 5,845,122). Claims 2, 4, 12 and 17 have

been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo in view of Nielsen et al., and further in view of Nealon (U.S. Patent No. 5,023,635). These rejections are respectfully traversed.

Applicant submits that the prior art of record fails to teach or suggest each and every element of the unique combination of elements of the claimed invention. Further, Applicant submits that the alleged combination(s) of the prior art of record would not have been obvious to one of ordinary skill in the art. Accordingly, these rejections should be withdrawn.

With respect to claim 1, the prior art of record fails to teach or suggest the combination of elements of the claimed invention, including the limitation(s) of “means for instructing the special image processing to be carried out by said special image processing means, *wherein the special image processing is canceled if at least two special image processes are instructed by said means for instructing and said at least two special image processes are combined into a predetermined combination, and the special image processing is not canceled if at least two special image processes are instructed by said means for instructing and said at least two special image processes are combined in a combination other than the predetermined combination that have been linked together in advance as suitable combinations of special image processes, wherein the predetermined combination is a combination of at least two special image processes set in advance..*” (emphasis added)

In the claimed invention, it is possible to combine special image processings together, e.g, the operator can set any suitable combination to be processed. However, the operator may also set any predetermined combination of processes as being incompatible for each user and may even combine three or more processes that may be processed with the claimed invention, e.g., as described on pages 23 to page 24 (line 9) of the present application.

For example, it is possible to combine processes such as "Hypersharpness" with "Hypertone" and "Hypersharpness" with "Portrait Finish" in the claimed invention. Therefore, the combination of Hypersharpness with Hypertone and/or Hypertone with Portrait Finish may be selected and processed by a user. Alternatively, Hypersharpness may be cancelled when the combination of Hypersharpness with Portrait Finish is erroneously selected by a user. Applicant submits that the subject matter of claims 1 and 23 is further described in the specification, including the special imaging processes generally described at pages 20 (Table 1), page 29 (lines 3-9), page 30 (lines 5-27) and page 31 (lines 1-21) of the present application; and the necessary image processes described on page 18.

However, the prior art of record fails to teach or suggest the ability to select combinations of suitable and unsuitable special image processes. The Examiner appears to admit that Kubo et al. does not disclose instructing means for prohibiting unsuitable combinations of the image processes. In order to overcome this shortcoming, the Examiner has suggested that Nielsen

et al. teach or suggest this feature. The Examiner has indicated that Nielsen et al. describe a radio button in FIG. 6 of the reference. However, the radio button may NOT be used for the execution of more than one option. Instead, the Examiner asserts that it would be obvious for one of ordinary skill in the art to modify both the Kubo et al. and the Nielsen et al. references to achieve the claimed invention.

For example, the Examiner points to FIG. 4 of Nielsen to show that the prior art of record teaches permissible and impermissible "combinations" of special image processes. The Examiner indicates that a user may make a single selection among "Title," "Book" and "Creation Date," e.g., since these options are mutually exclusive; and a single selection among the group of "Print only to File," and "Printer," since these options are mutually exclusive. However, Nielsen indicates that the single selection among "Title," "Book" and "Creation Date" will NOT have any effect on the selection between "Print only to File" and "Printer." (see col. 5, lines 54-60 of Nielson) Accordingly, two or more special image processes are not interrelated to permit or cancel permissible or impermissible combinations, respectively, of processes as with the claimed invention.

As discussed previously, Kubo and/or Nielsen do not teach or suggest any example that would permit the combination of "Title" and "Book" but reject the combination of "Title" and "Creation Date." In addition, the acceptable combination of "Print only to File" after the selection of "Title" has been made

has not been taught or suggested. Alternatively, the selection of "Title" has not been taught as being unacceptable after the selection "Printer" has been made. Finally, Kubo does not disclose any example similar to the claimed invention, e.g., where "2mm and 3 mm" margins is acceptable, but rejects "2mm and 4mm" margin combinations.

Accordingly, even if it were obvious to alter Kubo in view of Nielson as alleged by the Examiner, the unique functionality of the claimed invention would not be taught or suggested by the resulting combination. Accordingly, this rejection should be withdrawn.

Nielson and Kubo merely describe conventional radio buttons and lists, e.g., lists from which only one setting can be selected. In Kubo and/or Nielson, none of the alleged combinations referred to by the Examiner are set in advance, either permissible or impermissible combinations. Therefore, this rejection should be withdrawn.

With respect to additional claim 23, the prior art of record fails to teach or suggest the combination of elements of the claimed invention, including the limitation(s) of "means for instructing the special image processing to be carried out by said special image processing means, wherein unsuitable combinations of image processings are prohibited from being executed on the image by said special image processing means and suitable combinations of image processings are permitted to be executed on the image by said special image processing means, *said unsuitable combinations of image processings*

including a predetermined combination of at least two separate special image processes selected from the group consisting of LF Lens Correction, Hypersharpness, Hypertone, Facial Expression Improvement, RP Finish, Monotone Finish, Brightness Enhancement, Fine Finish, Portrait Finish, Red Eye Correction and Cross Filter processes, wherein said predetermined combination includes an erroneous combination of special image processes.” (emphasis added) Accordingly, this rejection should be withdrawn.

As alleged by the Examiner, the prior art of record fails to teach or suggest an image processing apparatus that permits selective processing of combinations of special image processes, e.g, prohibiting unsuitable combinations and/or permitting suitable combinations of special image processes. The only allegedly predetermined, unsuitable combinations of special image processes identified by the Examiner deal with a single special image process, e.g, selecting a single paper size from a group of paper sizes or a set of margin sizes from a set of margin sizes as identified by the Examiner during the personal interview. However, the prior art of record fails to teach or suggest any unsuitable combinations of separate special image processes. Accordingly, the rejections based upon Kubo et al. in view of Nielsen et al. should be withdrawn.

With respect to the Nealon reference, this reference has only been provided to show a system having a recording medium containing order information that is provided by a customer to means for instructing special

image processing. Therefore, Applicant submits that this reference fails to address the shortcoming identified hereinabove and therefore does not cure the improper combination of Kubo et al. in view of Nielsen et al. advanced by the Examiner.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicant respectfully submits that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application.

Accordingly, reconsideration and withdrawal of the claim rejection are respectfully requested. Moreover, Applicant respectfully submits that the instant application is in a condition for allowance.

As to the dependent claims, Applicant respectfully submits that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

CONCLUSION

Since the remaining patents cited by the Examiner have not been utilized to reject the claims, but rather to merely show the state-of-the-art, no further comments are necessary with respect thereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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